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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/534,672	05/12/2005	Marten Sandberg	10287.71	8511
27683 7590 07/21/2008 HAYNES AND BOONE, LLP 901 Main Street Suite 3100 Dallas, TX 75202				
EXAMINER MIRABEAU, MONIQUE A				
ART UNIT		PAPER NUMBER		
4112				
MAIL DATE		DELIVERY MODE		
07/21/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/534,672

**Applicant(s)**

SANDBERG, MARTEN

**Examiner**

MONIQUE MIRABEAU

**Art Unit**

4112

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 May 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/ISD)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date 05/12/2005

## **DETAILED ACTION**

### **Summary**

1. This initial Office Action based on the 10/534,672 application filed May 12, 2005.
2. Preliminary Amendment filed May 12, 2005 has been entered and fully considered.
3. Claims 1-5 are pending and have been fully considered.
4. The claims include a tool limitation, applicant is advised this is intended use language, as long as the prior art is capable of performing the same intended use.

### ***Drawings***

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p) (5) because they include the following reference character(s) not mentioned in the description: Figure 1, reference number 6. Corrected drawing sheets in compliance with 37 CFR 1.121(d), or amendment to the specification to add the reference character(s) in the description in compliance with 37 CFR 1.121(b) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

6. Claim 4 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claims 1-3. See MPEP § 608.01(n). Accordingly, the claim 4 not been further treated on the merits.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over

**WANNER (US 2001/0043885)** in view of **PUCHINGER et al. (US 4, 999, 164)**.

9. With respect to claim 1, **WANNER** teaches a multiple channel pipetting device.

**WANNER** discloses a multiple channel pipetting device (figure 1) (pipetting arrangement) that includes a shaft carrier (4, see figure 1) (carrier) to which first ends of the plurality of mutually parallel tip holder (13, see figure 2a) (nozzles), where the tip holder (13) (nozzles) are spaced only a slight distance apart, wherein second ends of the tip holder (13) (nozzles) are designed to carry a readily replaced pipetting tip (par. 0023, lines 5-6), and where the multiple channel pipetting device (figure 1) (pipetting arrangement) also includes means for establishing at the second end of a respective tip holder (13) (nozzle) a selective pipette plunger (7) (pressure for sucking fluid into and dispensing fluid from the times/tips).

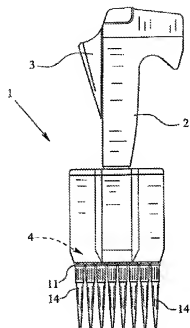


Fig. 1

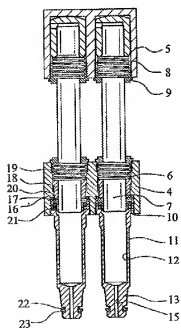
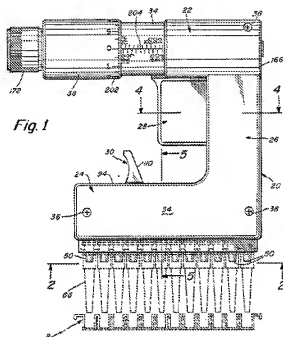


Fig. 2a

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10. **WANNER** does not appear to explicitly disclose that the nozzles are connected with the aid of respective screw joints; or that the nozzles are provided at their respective second ends with a driving formation.



11. However, **PUCHINGER et al.** teaches a pipetting device comprising a retaining cone for holding a slip-on pipette tip and pipette tip for such pipetting device. **PUCHINGER et al.** discloses a pipetting device (pipetting arrangement) that includes a body (2, fig. 8) (carrier) to which first ends of the parallel nozzles (54, fig. 2) are connected with the aid of respective screw threaded joints (41) (screw joints), where the second ends of the nozzles (54) are designed to carry a slipped on (readily replaced) (col. 8, line 61) pipette tip (10) (pipetting tip). The turning tool for respectively tightening and loosening the screw joint is not physically a part of the claimed device. The prior art is capable of performing the structure and function of the apparatus of the applicant.

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The tool does not further limit the device, and it would be obvious to one of ordinary skill in the art to use a screwdriver to tighten or loosen the screw joint (see MPEP 2112).

Fig. 2

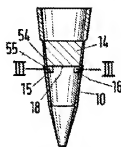
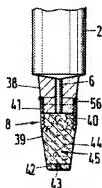


Fig. 8



**WANNER** and **PUCHINGER et al.** are analogous art because they are from the same field of endeavor biological/chemical analysis and testing, specifically multiple channel pipetting devices.

12. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the multiple channel pipetting device (pipetting arrangement) specifically the nozzles that includes a shaft carrier (carrier) to which first ends of the plurality of mutually parallel tip holder (nozzles), where the tip holder (nozzles) are

spaced only a slight distance apart, wherein second ends of the tip holder (nozzles) are designed to carry a readily replaced pipetting tip, and where the multiple channel pipetting device (pipetting arrangement) also includes means for establishing at the second end of a respective tip holder (nozzle) a selective pipette plunger (pressure for sucking fluid into and dispensing fluid from the times/tips) of **WANNER** so that said nozzles are connected with the aid of respective screw threaded joints (screw joints), where the second ends of the nozzles (54) are designed to carry a slipped on (readily replaced) pipette tip (pipetting tip) of **PUCHINGER et al.**

13. The motivation would have been in case of a leak, prevent having to completely taking the apart the device or parts being exchanged from the device, the problem is corrected by merely exchanging the pipetting shaft (11, fig. 1)(par. 0011, lines 12-14) of **WANNER** and the invention was modified so that the object will be accomplished in an effective manner (col. 3, lines 3-6) of **PUCHINGER et al.**

14. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

15. With respect to claim 4, **WANNER** as modified by **PUCHINGER et al.** teaches a pipetting device comprising a retaining cone for holding a slip-on pipette tip and pipette tip for such pipetting device. **WANNER** discloses a multiple channel pipetting device (arrangement) in that the tip holder (13) (nozzle) has adjacent its second end a narrowing end portion (fig. 1 and fig. 2a) to which a pipette tip (14) (tip) can be removably pushed (tightly and removable attached) into (par. 0023, lines 5-6).



**WANNER** and **PUCHINGER et al.** are analogous art because they are from the same field of endeavor biological/chemical analysis and testing, specifically multiple channel pipetting devices.

16. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the multiple channel pipetting device (arrangement) in that the tip holder (nozzle) has adjacent its second end a narrowing end portion to which a pipette tip (tip) can be removably pushed (tightly and removably attached) into of **WANNER** to include the multi-channel pipetter/pipetting device of **PUCHINGER et al.**

17. The motivation would have been to make the maintenance of the multiple channel pipetting device suitable for low stand measurements, more user friendly (par. 0009, lines 1-4) of **WANNER**.

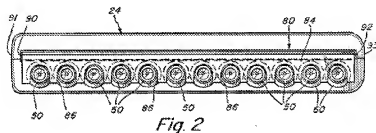
18. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

19. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over **WANNER (US 2001/0043885)** in view of **PUCHINGER et al. (US 4, 999, 164)** as applied to claims 1 and 4 above, and in further view of **LYMAN et al. (US 4, 824, 642)**.

20. With respect to claim 2, **WANNER** as modified by **PUCHINGER et al.** does not teach the groove. However, **LYMAN et al.** teaches a multi-channel pipetter. **LYMAN et al.** discloses a multi-channel pipetter (arrangement) the driving formation includes a slot (86) (groove) (col. 4, lines 5-7) on the free end of the tip holder (50) (nozzle) in the axial plane (figure 2). The presently claimed tool which includes a blade that co-acts with the groove is not physically apart or intended to be used with the device. Further prior art is

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capable of performing the function of the apparatus of the applicant. Therefore, the tool does not further limit the device (see MPEP 2112).



**WANNER, PUCHINGER et al.** and **LYMAN et al.** are analogous art because they are from the same field of endeavor biological/chemical analysis and testing, specifically multiple channel pipetting devices.

21. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the multiple channel pipetting device (pipetting arrangement) of **WANNER** as modified by **PUCHINGER et al.** to include the multi-channel pipetter (arrangement) in that the driving formation includes a slot (groove) on the free end of the tip holder (nozzle) in the axial plane in view of **LYMAN et al.**

22. The motivation would have been that the stripper plate would be free to move vertically up and down in the housing (col. 4, lines 9-10) as taught by **LYMAN et al.**

23. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

24. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over WANNER (US 2001/0043885) in view of PUCHINGER et al. (US 4, 999, 164) and LYMAN et al. (US 4, 824, 642) as applied to claim 2, and further in view of EIHUSEN et al. (US 5, 529, 460).

25. With respect to claim 3, **WANNER** as modified by **PUCHINGER et al.** and **LYMAN et al.** **LYMAN et al.** discloses a multi-channel pipetter (arrangement) that the driving formation is a slot (86) (groove) (col. 4, lines 5-7) which is centered with respect to the axis of the tip holders (50) (nozzle) (figure 2). The tool includes a cross-headed blade for co-action with the cross-shaped groove.
26. **LYMAN et al.** does not appear to explicitly disclose that the groove is a cross-shaped groove.
27. However, **EIHUSEN et al.** teaches a pressure washer comprising a cruciform groove (77, fig. 13) (cross-shaped groove). It would have been obvious to substitute.

**Fig. 13**



28. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the multiple channel pipetting device of **WANNER** as modified by **PUCHINGER et al.** and **LYMAN et al.** to include the cruciform groove (cross-shaped groove) of **EIHUSEN et al.** The prior art is capable of performing the structure and function of the apparatus of the applicant. The tool does not further limit the device, and it would be obvious to one of ordinary skill in the art to use a screwdriver to tighten or loosen the screw joint (see MPEP 2112).

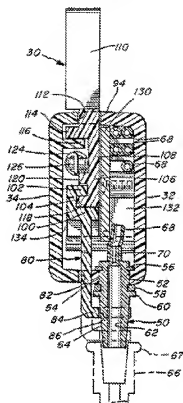
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29. The motivation would have been simple substitution of one known element the slot (groove) of **LYMAN et al.** with another cruciform groove (cross-shaped groove) of **Eihusen et al.** (MPEP 2143 B)

30. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

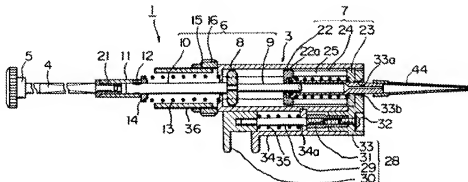
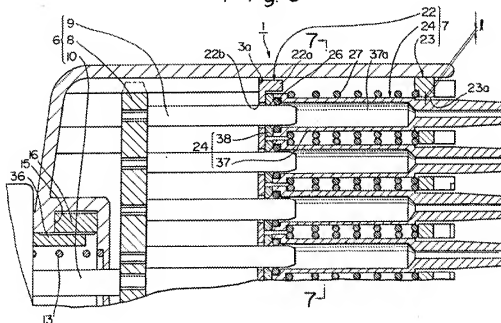
31. Claims **5** is rejected under 35 U.S.C. 103(a) as being unpatentable over **WANNER (US 2001/0043885)** in view of **PUCHINGER et al. (US 4, 999, 164)** as applied to claims **1 and 4**, and in further view of **OSHIKUBO (US 5, 021, 217)**.

32. With respect to claim **5**, **WANNER** as modified by **PUCHINGER et al.** teaches a multiple channel pipetting device which carries a elastomer ring, in particular O-ring (**WANNER**, 21, fig. 2a) (par. 0032, lines 8) (sealing ring) which seals against the inner circumference of the pipette tip (14) (pipetting tip).

*Fig. 5*

33. **WANNER** does not appear to explicitly disclose that the end portion of the nozzle has a peripheral groove which carries a sealing ring.

34. However, **OSHIKUBO** discloses a multipipet (arrangement) that the upper (end) portion of the cylinder holder (23) (nozzle) has a peripheral groove (col.3, lines 53-55) which carries an O-ring (26) (sealing ring) (fig. 5 and fig. 6).

*Fig.5**Fig.6*

**WANNER, PUCHINGER et al.** and **OSHIKUBO** are analogous art because they are from the same field of endeavor biological/chemical analysis and testing, specifically multiple channel pipetting devices.

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35. At the time of the invention, it would have been obvious to one of ordinary skill in the art to modify the multiple channel pipetting device which carries a elastomer ring, in particular O-ring (sealing ring) which seals against the inner circumference of the pipette tip (pipetting tip) of **WANNER as modified by PUCHINGER et al.** to include the multipipet (arrangement) that the upper (end) portion of the cylinder holder (nozzle) has a peripheral groove which carries an O-ring (sealing ring) of **OSHIKUBO**.

36. The motivation would have been that the sealing jacket which forms the plunger seal (16) also, incidentally, has a circumferential contact surface for the stripping ring (18), so that a constant, perfect force transmission takes place (par. 0032, lines 10-14) of **WANNER and PUCHINGER et al.** with the o-ring is substantially completely accommodated within the peripheral groove, to provide sealing (col. 3, lines 55-64) of **OSHIKUBO**.

37. Therefore, the invention as a whole would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made.

### ***Conclusion***

38. The prior art made of record and not relied upon is considered pertinent to the applicants disclosure.

**The reference Cronenberg et al. (US 2002/0001545) discloses mechanisms are provided for automatically removing tips from a pipette nozzle and/or for detecting the type of tip mounted to the nozzle (abstract).**

39. Any inquiry concerning this communication or earlier communications from the examiner should be directed to MONIQUE MIRABEAU whose telephone number is

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(571) 270-5543. The examiner can normally be reached on M-F, alternate F off (8am-4pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Barbara Gilliam can be reached on (571) 2721330. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

MM

/Barbara L. Gilliam/  
Supervisory Patent Examiner, Art Unit 4128